

## **ADMINISTRATIVE PANEL DECISION**

**BASF SE v. Jackson Richard, Hill Commercial Brokers**  
**Case No. D2023-5364**

### **1. The Parties**

The Complainant is BASF SE, Germany, represented by IP Twins, France.

The Respondent is Jackson Richard, Hill Commercial Brokers, United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <basfholdingsouthafrica.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 27, 2023. On December 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 10, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 15, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 8, 2024.

The Center appointed Shwetasree Majumder as the sole panelist in this matter on February 15, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is BASF SE, a German company operating in the field of chemicals, and owning several trademark registrations worldwide for BASF, among which are:

- International Trademark Registration No. 638794 for BASF, registered on May 3, 1995;
- International Trademark Registration No. 909293 for BASF, registered on October 31, 2006.

According to the Whois records, the disputed domain name was registered on November 5, 2023, and, at the time of filing of the Complaint, resolved to a parked page with pay-per-click links.

As disclosed by the Registrar, the Respondent is reportedly based in the United Kingdom. Otherwise, no information is known about the Respondent.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that disputed domain name is confusingly similar to its famous trademark BASF. The Complainant argues that its trademark BASF is reproduced identically within the disputed domain name, in highly visible and recognizable position and hence the first element is satisfied. The Complainant contends that BASF trademark is associated with the terms "holdings" and "South Africa" in the disputed domain name, which undoubtedly relate to a legal company form and the country of South Africa, where the Complainant is active.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name. The Respondent is not commonly known by the disputed domain name, and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The Complainant asserts that its trademark BASF is a well-known trademark and has cited several URDP decisions in support of this contention. The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark BASF is well known. The Complainant argues that given the well-known character of its trademark BASF, the Respondent knew or should have known of its existence when they registered the disputed domain name.

The Complainant contends that the Respondent registered the disputed domain name for creating confusion with the Complainant's trademark and to divert or mislead Internet users. It is further argued that the parked page with pay-per-click commercial links cannot be seen as an element of good faith on the Respondent's part.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

As per paragraph 5(f) of the Rules where a respondent does not submit a response, in the absence of exceptional circumstances, the panel shall decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response. A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

It remains incumbent on the Complainant to make out its case in all respects under paragraph 4(a) of the Policy. Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required by a preponderance of evidence:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms "holdings" and "south africa" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The terms “holdings” and “south africa” in the disputed domain name are a suffix to the Complainant’s trademark BASF. Hence, the disputed domain name may be mistaken as Complainant’s South African business website. Accordingly, the composition of the disputed domain name is such to carry a risk of implied affiliation to the Complainant and its trademark BASF, which cannot constitute fair use, particularly given the ultimately commercial use to which the disputed domain name is being put (i.e., pay-per-click links).

In absence of a response from the Respondent and the presence of pay-per-click commercial links on the disputed domain name, the Panel cannot see how the Respondent can have rights or legitimate interests in the disputed domain name. The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. One of these circumstances is where a respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark.

In the present case, the Panel notes that the Respondent has incorporated the Complainant’s trademark in the disputed domain name in its entirety. Further, the Respondent has pay-per-click advertisements links on the disputed domain name. The Panel is of the of view that the registration of the disputed domain name is an intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s trademark BASF.

The Panel is of the view that the Complainant’s trademark BASF is a well-known trademark. Indeed past UDRP panels have also held so. See, e.g., *BASF SE v. Jim Welsh*, WIPO Case No. [D2010-2000](#), and *BASF SE v. jing liu/liujing*, WIPO Case No. [D2014-1889](#). UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4. Hence, the Panel is satisfied that the Respondent knew, or in any event ought to have known, of the Complainant’s mark’s existence.

The Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <basfholdingsouthafrica.com> be transferred to the Complainant.

*/Shwetasree Majumder/*

**Shwetasree Majumder**

Sole Panelist

Date: February 29, 2024